

REMARKS

Status of the Claims

Upon entry of the amendment above, claims 1-23 and 25-47 will remain pending, claims 1, 19, 30, and 47 being independent. Claims 10-12 stand withdrawn from consideration as being directed to non-elected invention(s).

Summary of the Office Action

Claims 1, 3, 4, 8, 9, 13, 14, 16, 18-23, 25, 27-36, and 38-40 are rejected under 35 USC §102(e) as being anticipated by DACHGRUBER et al. (U.S. Patent No. 6,360,454, hereafter "DACHGRUBER").

Claims 1, 2, 4, 5, 8, 9, and 17 are rejected under 35 USC §102(b) as being anticipated by RATHMELL (U.S. Patent No. 4,043,059).

Claims 1-3, 8, 9, 14, 17, and 18 are rejected under 35 USC §102(e) as being anticipated by FILICE (U.S. Patent No. 6,381,877).

Claims 5-7, 15, 16, 19-23, and 25-40 are rejected under 35 USC §103(a) as being unpatentable over DACHGRUBER in view of FILICE.

Response to the Office Action

A. Substance of Interview

Applicant's undersigned representative thanks the Examiner for her time and attention during a personal interview on May 16, 2006, during which time Applicants' invention was discussed.

At the outset, Applicant's representative briefly summarized the invention as including a device that can be used by a person to prevent hyper-flexion of a joint, such as a device use with a boot applied against the front of the boot extending from the area of the tibia down along the instep. Unlike various prior art references relied upon in the Office action, Applicant's invention is directed to limiting, i.e., stopping the bending of the joint,

such as the ankle, beyond a certain angle, such as 30 to 45 degrees, beyond which angle the joint is susceptible to injury. By contrast, the prior art is concerned with modifying the rigidity of a boot, for example. In addition, Applicant's representative pointed out, the characterization in the Office action that certain prior art limits bending "to some degree" is a misnomer, since, Applicant's claimed invention is directed to limiting movement, i.e., preventing movement beyond a certain extent.

The Examiner indicated that Applicant's claims are "too functional" and that all that is needed to reject them is something that has the ability described in such claims. For example, the Examiner pointed out, elements 98 of DACHGRUBER can be regarded as abutments which engage each other if the stiffener is bent far enough. In response, Applicant's representative explained that there is no teaching or suggestion in DACHGRUBER regarding any such teaching, particularly during use of the stiffener. Further, it was pointed out that although Applicant recognizes that the USPTO can, according to current state of the law and USPTO procedure, rely upon a "broadest reasonable interpretation" of the claims, such interpretation must still be made in light of the specification and in the manner understood by one of ordinary skill in the art.

No agreement was reached other than a claim which were to include the limitations found in a combination of independent claim 30 and dependent claims 33, 34, 3, and 28. Such a claim is presented above as new claim 47.

B. Summary of Amendments

In the amendment above, paragraphs 0037, 0039, and 0040 of the specification have been amended to improve their form as well as, in paragraph 0040, to add a description of a feature of the frame 1 shown in FIG. 3, for example, i.e., that the frame 1 includes a continuous outer periphery.

Independent claim 1 has been amended to add some "structural" character to its dimensions, in the form of a means-plus-function limitation, which limitation should be

interpreted according to the requirements of 35 USC §112, sixth paragraph.

Claim 4 has been amended to refer to the “notch” of parent claim 2 as a “beveled notch.”

Dependent claim 5 has been amended for clarification (i.e., “sides” to ends), consistent with an amendment to paragraph 0037.

Independent claims 19 and 30 have been amended to include, inter alia, a *structural* limitation whereby the “at one abutment” comprises “a beveled notch.” The term “beveled,” consistent with the specification and drawings, relates to a notch having surfaces which extend at an angle relative to one another, i.e., they are not parallel. Other clarifying amendments are also made to claim 19.

Claim 29 has been amended for consistency with an amendment made to parent claim 19, and claims 32 and 33 have been amended for consistency with an amendment made to parent claim 30.

New dependent claims 41-46 have been added. Claims 41-43 are directed to the rigid frame being made of a material that defines a continuous outer periphery along the length and width of the frame or the protective article of the invention. Claims 44-46 are directed to the “at least one notch” comprising a plurality of spaced apart notches.

Lastly, as mentioned above, new independent claim 47 corresponds to a claim which the Examiner has proposed for allowance during the aforementioned interview.

C. The Allowance of Claim 1 and Claims Depending Therefrom

Applicant kindly requests reconsideration and withdrawal of the rejections of claim 1 and the claims depending therefrom.

1. DACHGRUBER

Claim 1 is directed to a protective article for the joint of a person’s body (such as an ankle joint). Following entry of the amendment above, the rigid frame of such protective article comprises the following:

means for allowing bending of the protective article and bending of the joint along at least one bending direction through a predetermined angle of bending, said means comprising at least one bending zone having at least one abutment with opposed edges, said opposed edges being spaced apart a predetermined amount in a first and unbent position of the protective article, and spaced apart by an amount less than said predetermined amount in a second and bent position of the protective article;

in said second and bent position of the protective article, said abutment of said means for allowing bending comprising ***means for limiting bending of the frame and limiting bending of the joint along said bending direction at said predetermined angle of bending***;

said rigid frame having a rigidity of a magnitude to avoid hyperflexion of the joint beyond said predetermined angle of bending while the protective article is in said second and bent position. (Emphasis added)

Among other things, claim 1 includes at least one means-plus-function limitation, emphasized in bold and italics above. Pursuant to the provisions of 35 USC §112, sixth paragraph, that limitation “shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” As stated in *In re Iwahashi*, 888 F.2d 1370, 1375 n.1, 12 USPQ2d 1908, 1912, n.1 (Fed. Cir. 1989), “Section 112 ¶ 6 cannot be ignored when a claim is before the PTO any more than when it is before the courts in an issued patent.”

Therefore, the recited “means for limiting bending of the frame and limiting bending of the joint ...” must be interpreted to cover the corresponding structure and material described in the specification and equivalents thereof.

Based upon an interpretation of claim 1 set forth above, the elements 98 and 100 of DACHGRUBER (identified near the middle of page 4 of the Office action as “notches” and “abutments,” respectively) would not be found to cover Applicant’s abutments to ***limit*** bending, nor their equivalents. There is no such disclosure in DACHGRUBER and the apparent contortion that would be necessitated to bring any of elements 98 or 100 into a

position to **limit** bending would not correspond to structure or material described by Applicant, or equivalents thereof.

In Section 2111.01 of the Manual of Patent Examining Procedure (MPEP), the USPTO cites an unpublished decision of the Court of Appeals for the Federal Circuit, which is very relevant to the issues presented in the rejection of Applicant's claims:

In re Weiss, 989 F.2d 1202, 26 USPQ2d 1885 (Fed. Cir. 1993) (unpublished decision - cannot be cited as precedent) (The claim related to an athletic shoe with cleats that "break away at a preselected level of force" and thus prevent injury to the wearer. The examiner rejected the claims over prior art teaching athletic shoes with cleats not intended to break off and rationalized that the cleats would break away given a high enough force. The court reversed the rejection stating that when interpreting a claim term which is ambiguous, such as 'a preselected level of force,' we must look to the specification for the meaning ascribed to that term by the inventor." The specification had defined "preselected level of force..." as that level of force at which the breaking away will prevent injury to the wearer during athletic exertion. It should be noted that the limitation was part of a means plus function element.)

As in the decision cited by the USPTO, a proper interpretation of Applicant's claim limitation "means for limiting bending of the frame and limiting bending of the joint along said bending direction at said predetermined angle of bending" requires that reference be made to the specification to determine "the meaning ascribed to that term by the inventor." Such reference would establish that Applicant's specification defines the predetermined angle as one that protects the joint from injury by preventing hyper-flexion of the joint. See, e.g., paragraphs 0008, 0010, 0030 and 0031.

Further, reference to paragraph 0030 of the specification would establish that ***limiting*** bending means that bending via the abutment(s) is stopped, and that "the

constituent material of the frame 1 itself recovers the bending forces”

DACHGRUBER fails to teach or suggest any such **limiting** of bending. In fact, there is no disclosure of a limiting of bending at all in DACHGRUBER. In contrast to Applicant’s invention, the function of DACHGRUBER’s stiffener is to affect the stiffness of the boot, as evidenced in the description provided by the paragraph beginning in column 3, line 59, to column 4, line 16, where DACHGRUBER describes the stiffener 24 being fitted within a recess 40 of the tongue 22. In one embodiment, the recess 40 includes an “open area 42” that is provided to allow the stiffener to have no appreciable affect on the flexing of the boot: “For example, the recess 40 may be configured to allow the footwear to be flexed up to an angle of 45° from its rest position, without the end of the stiffener abutting the end of the recess.” Thereafter, the flexibility of the stiffener controls further flexing of the boot. Thus, DACHGRUBER describes his invention as allowing flexing **beyond** 45° (in contrast to certain of Applicant’s dependent claims, such as claim 16, which **limit** flexing at 45°).

In another embodiment described within the aforementioned paragraph, “it should be appreciated that the present is not limited in this respect and that the recess 40 may be made substantially the same size as the tongue stiffener 24, where the tongue stiffener 24 is not intended to move appreciably relative to the tongue 22.” (See column 4, lines 12-16.) That is, the stiffener merely affects the quality of the flexion of the boot, but no structure of the stiffener is provided for **limiting** such flexion.

The comment in the Office action that elements 98, 100 are “abutments” is believed to be erroneous. The surfaces of elements 98, 100 are not disclosed by DACHGRUBER as abutting to limit bending of the stiffener 24, nor as reaching a point at which they come together to a maximum extent which limits further bending of the stiffener 24. Affecting flexion of the stiffener “to some degree,” as specified in the rejection, does not meet the terms of the rejected claims, including the means-plus-function limitation, which specify **limiting the bending** of Applicant’s frame.

Notches 98 of DACHGRUBER, cited in the rejection as "abutments," are not abutments. Instead, DACHGRUBER describes the notches 98 as follows (see column 7, lines 50-65):

... one or both sides 39a, 39b [of the stiffener 24] may include a plurality of *flex inducing members such as grooves or notches 98* * *
* ... due in part to the presence of the grooves, the mid-section is able to *flex* to a greater extent than other portions of the stiffener. The grooves 98 may also act to minimize kinking of the mid-section of the stiffener as the tongue and stiffener are flexed. In this respect, *the grooves 98 provide controlled flexing of the stiffener* (emphasis added).

Apertures 100 of DACHGRUBER, cited in the rejection as "abutments," are not abutments. Instead, DACHGRUBER describes the apertures 100 as follows (see column 7, line 66, to column 8, line 4):

... at least one aperture 100 may be formed completely through the stiffener 24, with the aperture 100 being shaped and dimensioned in accordance with the desired flexibility or rigidity. Like the grooves 98, the apertures 100 may also act to minimize kinking of the stiffener as the tongue and stiffener are flexed.

Thus, the apertures 100, according to DACHGRUBER, serve the purpose of that of the grooves 98, i.e., ***to facilitate flexing – not to limit flexing.***

At least for the reasons advanced above, reconsideration and withdrawal of the rejection of claim 1, and claims depending from claim 1, over DACHGRUBER is kindly requested.

In addition, DACHGRUBER fails to teach or suggest the invention of claim 3, which depends from claim 1. In claim 3, Applicant specifies that "the frame is flexed on a flexible and substantially inextensible membrane ***against movement along the membrane.*** As Applicant explained in his reply to the previous Office action (which explanation has not yet

been rebutted), column 4, lines 11-16 of DACHGRUBER, again referenced in the rejection, fails to support the rejection. Therein, DACHGRUBER mentions that the previously described sliding of the stiffener relative to the tongue could be made so that it is not "intended to move appreciably relative to the tongue 22." Nevertheless, even in that non-illustrated embodiment, the stiffener moves.

Still further, in claim 3, Applicant specifies that the "inextensible membrane" is part of the claimed protective article. By contrast, in DACHGRUBER, there is no such membrane of the stiffener.

2. RATHMELL

As in the previous Office action, the Office action to which Applicant now replies asserts that RATHMELL includes a rigid frame. Reference is made in the Office action to Fig. 1 of RATHMELL, although the "rigid frame" of a "protective article for a joint of a person's body" is not identified. Within the rejection, elements 1 and 2 of RATHMELL's boot are identified as "the envelope 1, 2." Further, In column 1, lines 35-39, RATHMELL explains that the corrugated sections 4 are flexible. The lines of corrugation enhance the flexibility of section 4. Therefore, Applicant submits that the flexible section 4 of RATHMELL and the rigid frame according to Applicant's invention are patentably different, particularly when one interprets the above-mentioned means-plus-function limitation of claim 1.

That is, when the recited "means for limiting bending of the frame and limiting bending of the joint ..." is interpreted to cover the corresponding structure and material described in the specification and equivalents thereof, one skilled in the art would find that RATHMELL fails to teach or suggest Applicant's rigid frame and abutments or equivalents thereof.

At least for these reasons, reconsideration and withdrawal of the rejection of claim 1, and claims depending therefrom, is kindly requested.

In addition to the foregoing, Applicant directs the Examiner's attention to new claim 41, which depends from claim 1, claim 41 specifying that the "rigid frame is made of a material defining a continuous outer periphery along a length and width of the protective article." No such continuous outer periphery defined by a material of the rigid frame is taught or suggested by RATHMELL. Instead, RATHMELL discloses a flexible corrugated section 4 in front of the hinges 3 so that the section 4 collapses upon itself when the lower leg part of the boot pivots forwardly. The "relatively rigid fins" are discontinuous along the length of the structure comprised of the corrugated section 4 and the fins 5.

3. FILICE

FILICE discloses a boot having a flexible ankle cuff section (see column 1, lines 33-38). The ankle cuff section is constructed of synthetic material of equal or greater flexibility than the lower and the upper sections of the boot (see column 1, lines 47-50). The ankle cuff section 40 and the flexible tongue section 26 are each constructed and designed to provide controlled flexibility, *i.e.*, controlled to have an equal or greater flexibility in desired directions than the lower or the upper sections 10, 30 of the boot and the upper and lower parts 22, 24 of the tongue (see column 2, lines 44-52).

Section 26 is flexible and is made of moldable elastomers, for example (see column 3, lines 8-31). It is also explained (see, *e.g.*, column 4, lines 1-8) that the relatively thick central region 27 of the tongue abuts the lateral edges 44 of the flexible cuff section. This prevents migration of the tongue 20 from the desired frontal position to the left or to the right of the user's foot.

In any event, there is no disclosure of an abutment, nor of an abutment that limits bending beyond a predetermined angle, as specified in Applicant's claim 1. In addition, when the recited "means for limiting bending of the frame and limiting bending of the joint ..." is interpreted to cover the corresponding structure and material described in the specification and equivalents thereof, one skilled in the art would find that FILICE fails to teach or suggest Applicant's rigid frame and abutments or equivalents thereof.

In this regard, the observation on page 5, line 4 of the Office action, "that 'rigid' is a relative term" is not responsive to the interpretation one must give to Applicant's invention when read in light of the specification and pursuant to the standard provided for in 35 USC §112, sixth paragraph.

Withdrawal of the rejection based upon FILICE, therefore, is kindly requested.

4. DACHGRUBER in View of FILICE

Certain dependent claims are additionally rejected on the basis of the combination of DACHGRUBER and FILICE. As explained on page 6, lines 5-8 of the Office action, FILICE is relied upon for the proposition that it would have been obvious to have replaced DACHGRUBER's frame 24 with that of FILICE.

However, FILICE fails to remedy the deficiencies of DACHGRUBER explained above. Accordingly, although Applicant respectfully submits that one skilled in the art would not have made the substitution of frames suggested in this rejection, this rejection should be withdrawn at least for reasons given above with regard to the rejection based solely upon DACHGRUBER.

D. The Allowance of Claims 19 and 30 and Claims Depending Therefrom

Applicant kindly requests reconsideration and withdrawal of the rejections of independent claims 19 and 30, and the claims depending therefrom.

In this regard, Applicant submits that even when one considers Applicant's claims in terms of the "broadest reasonable interpretation" standard mentioned by the Examiner during the aforementioned interview, the rejections fail.

Prior to a discussion of claims 19, 30 and claims depending therefrom, Applicant next summarizes, in the form of *ex parte* appeals decided by the Court of Appeals for the Federal Circuit and a citation from the Manual of Patent Examining Procedure (MPEP), precedents for claim interpretation during prosecution of a patent application at the USPTO.

Section 2111.01 explains that “[d]uring examination, the claims must be interpreted as broadly as their terms reasonably allow.” Cited therein are various cases of the Court of Appeals for the Federal Circuit and its predecessor court, the Court of Claims and Patent Appeals.

In re Cortright, 165 F.3d 1353, 1358, 49 USPQ2d 1464, 1467 (Fed. Cir. 1999), provides a representative summary of the state of the law and procedure regarding claim interpretation at the USPTO:

Although the PTO must give the claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach. See *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997) (“[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art”); *In re Bond*, 910 F.2d, 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) (“It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, ... and that claim language should be read in light of the specification *as it would be interpreted by one of ordinary skill in the art.*”)(emphasis added); see also M.P.E.P. §2111.01 (“[T]he words of a claim ... must be read as they would be interpreted by those of ordinary skill in the art.”).

Accord, *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004) and *In re Okuzawa*, 537 F.2d 545, 190 USPQ 464 (CCPA 1976).

In addition, the case of *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), also cited in the aforementioned MPEP §2111.01, explains that terms of a claim are to be interpreted as having the meanings stated by the Applicant (i.e., the subject matter that the Applicant “regards as his invention,” in the words of the second paragraph of 35 USC §112):

During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art.

* * *

Thus the inquiry during examination is patentability of the invention as "the applicant regards" it; and if the claims do not "particularly point[] out and distinctly claim[]," in the words of section 112, that which examination shows the applicant is entitled to claim as his invention, the appropriate PTO action is to reject the claims for that reason. *Burlington Industries*, 822 F.2d at 1583-84, 3 USPQ2d at 1438; *In re Cormany*, 476 F.2d 998, 999-1001, 177 USPQ 450, 451-52 (CCPA 1973); *[In re] Prater*, 415 F.2d at 1404, 162 USPQ at 550.

1. DACHGRUBER

Although independent claim 19 is included in the §102(e) rejection based upon DACHGRUBER, claim 19 is not specifically referenced in the statements in support of the rejection.

In claim 19 Applicant calls for a sports apparatus that includes the following: an envelope (i.e., something with reference to which the protective article of the invention can be mounted upon or within; see element O in the drawings) to be placed over a person's joint (such as an ankle); a protective article for protecting the joint from hyper-flexion, which article comprises a frame (such as element 1) that is detachably mounted relative to the envelope; the frame including at least one bending zone (such as element 2) between first and second support areas (elements 100, 101, e.g.); the frame being more rigid, at least in the bending zone, than the envelope; "said bending zone having a flexibility adapted to allow bending of the frame in a bending direction within said bending plane through a range of bending during use of the sports apparatus between an initial position of the frame" (Fig.

1B) “and a maximum bent position of the frame” (Fig. 1A); the frame further including “at least one abutment comprising at least one beveled notch (element 4, e.g.) between a pair of opposed edges within said bending zone”; “said pair of opposed edges being movable relative to each other in said bending direction from said initial position of the frame to said maximum bent position of the frame, said pair of opposed edges not being further movable in said bending direction to thereby define a maximum bending of the frame and the joint at an end of said range of bending in said bending direction”; and “said frame having a rigidity, at least in said bending zone, sufficient to prevent said bending of said frame at said bending zone beyond said range of bending during use of the sports apparatus and to avoid hyper-flexion of the joint.”

Independent claim 30 includes limitations similar to many of those of claim 19, as well as a limitation by which the aforementioned maximum bending is specified as being no greater than an angle of 45°.

Page 3, lines 8-10, and page 7, lines 1-4 of the Office action include the statement that the “edges of the apertures or notches of DACHGRUBER “are capable of having the function of limiting *or resisting flexion to some degree ...*” (emphasis added).

A careful reading of each of Applicant’s independent claims, however, will show that Applicant’s invention has not been, nor is it now, as broadly stated as that. That is, rather than merely specifying a structure that *resists flexion to some degree*, the structure of Applicant’s invention **limits** bending of the frame of the protective article beyond the end of a predetermined angle of bending to prevent hyperextension of one’s joint.

That is, Applicant’s invention is not merely directed to providing a modification of the flexibility of a boot, a sports article/apparatus. Rather, Applicant’s invention includes a frame which provides a controlled **limit** to the extent to which a person’s joint can be bent so that hyperextensions can be prevented.

The rejection, which posits (page 4, lines 10-12 of the Office action) that “when the device 24 of Dachgruber et al is flexed at certain degree, the abutting surfaces or edges are capable of having the function to limit flexion to some degree further bending of the frame and joint,” is therefore inconsistent with the standard of claim interpretation advanced by MPEP §2111.01, as well as with the aforementioned precedential cases of *Cortright* and *Zletz* (“When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant’s invention and its relation to the prior art.” (893 F.2d at 321, 13 USPQ2d at 1322.))

That is, nowhere in the disclosure of DACHGRUBER is there mention of any “abutment” 98, 100 having abutting edges or even compressing a compressible material therebetween which causes the opposed edges from not moving forward further to thereby limit further movement. Instead, DACHGRUBER’s elements 98, 100 permit flexing without concern for a limit. In fact, those elements are provide to facilitate flexion.

Surfaces of elements 98 and 100, for example, are not disclosed by DACHGRUBER as abutting to limit bending of the stiffener 24, nor as reaching a point at which they come together to a maximum extent which limits further bending of the stiffener 24. Affecting flexion of the stiffener “to some degree,” as specified in the rejection, does not meet the terms of the rejected claims which reference ***limiting the bending*** of Applicant’s frame.

In addition, in DACHGRUBER’s boot, the stiffener 24 slides relative to the tongue to allow the boot to be flexed. Neither of the elements 98 and 100 limits flexion.

Further, even if the stiffener 24 is removably attached to the tongue 22, it is not the stiffener itself that carries two opposed edges. Instead, it is merely an end of the stiffener abutting a surface of the “envelope,” *i.e.*, the tongue or upper of the boot. Therefore, for the stiffener 24 of DACHGRUBER to function properly for any given boot, the boot has to be appropriately modified so that an appropriately dimensioned recess (like recess 40 of

DACHGRUBER) so that the end of the stiffener 24 can engage the end of the recess at the appropriate time.

By contrast, with Applicant's frame, recited in the rejected claims, it is the structure of the frame itself, independent of the envelope (*i.e.*, boot, liner, glove, *etc.*), that controls the limit of bending.

To the extent that the aforementioned statement on page 4, lines 10-12, of the Office action results from a position that Applicant's claims are "too functional" (as mentioned during the interview on May 16, 2006), Applicant respectfully directs attention to MPEP §2173.01:

Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

Further, as explained by *Zletz, supra*, "[w]hen the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning"

Still further, in each of independent claims 19 and 30, Applicant calls for "at least one beveled notch." This "structural" limitation is directed to a part of the bending zone in which a pair of surfaces extend, relative to each other, non-parallel, such as notches 4 in Applicant's drawings.

The only reference to a "beveled notch" in the rejection appears to be the mention on page 6, line 3, where a mere reference to "figure 5" of DACHGRUBER is made. In Fig. 5 of DACHGRUBER, elements 98 and 100 do not appear, so it would appear that the rejection here does not intend to rely thereupon. On the other hand, it would appear clear that elements 98 and 100 cannot be regarded as "notches" or "beveled notches."

Therefore, it is Applicant's best guess that the rejection must be intended to rely upon the depression 60, or surface(s) thereof. However, depression 60 is not in the stiffener 24 of DACHGRUBER, stiffener 24 having been identified in the Office action as corresponding to Applicant's claimed frame. Therefore, Fig. 5 fails to provide a teaching or suggestion of Applicant's claimed "beveled notch" in a bending zone of the frame.

Still further, depression 60 of DACHGRUBER is provided for receiving the hook 50 and would not appear to relate to abutments in a bending zone. Further, new claims 45 and 46, which depend from independent claims 19 and 30, respectively, call for a plurality of spaced apart beveled notches. DACHGRUBER, whether considering depression 60 or elements 98, 100, fails to teach or suggest the limitations of claims 45 and 46.

In addition to the foregoing, as mentioned above in connection with the rejection of Applicant's claim 1, DACHGRUBER fails to provide for the limitation of bending of the frame and the joint beyond an angle of 45°. That is, in contrast to Applicant's claimed invention, the function of DACHGRUBER's stiffener is merely to affect the stiffness of the boot, as evidenced in the description provided by the paragraph beginning in column 3, line 59, to column 4, line 16, where DACHGRUBER describes the stiffener 24 being fitted within a recess 40 of the tongue 22. In one embodiment, the recess 40 includes an "open area 42" that is provided to allow the stiffener to have no appreciable affect on the flexing of the boot: "For example, the recess 40 may be configured to allow the footwear to be flexed up to an angle of 45° from its rest position, without the end of the stiffener abutting the end of the recess." Thereafter, the stiffness of the stiffener affects the extent to which the boot can be flexed further.

Thus, rather than limiting any bending movement to 45°, DACHGRUBER contemplates allowing flexing **beyond** 45°.

At least for the foregoing reasons, withdrawal of the rejection of claims 19 and 30, and the claims depending therefrom, over DACHGRUBER, is requested.

2. DACHGRUBER in View of FILICE

As mentioned above, independent claims 19 and 30 are additionally rejected on the basis of the combination of DACHGRUBER and FILICE. However, as explained on page 6, lines 5-8 of the Office action, FILICE is relied upon for the proposition that it would have been obvious to have replaced DACHGRUBER's frame 24 with that of FILICE.

This rejection, therefore, appears to be intended to address the limitations in Applicant's independent claims 19 and 30 (as well as in dependent claims 5-7, e.g.) of supports or support areas (such as elements 100, 101 in Applicant's drawing).

However, FILICE fails to remedy the deficiencies of DACHGRUBER explained above. Accordingly, although Applicant respectfully submits that one skilled in the art would not have made the substitution of frames suggested in this rejection, this rejection should be withdrawn at least for reasons given above with regard to the rejection based solely upon DACHGRUBER.

SUMMARY AND CONCLUSION

The grounds of rejection advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

A check is attached for payment of a fee for a Request for Continued Examination (RCE); for extra claims and an extra independent claim; and for an extension of time for one month. No additional fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Further, although an extension of time for a single month is believed to be necessary at this time, if it were to be found that an additional extension of time were necessary to render this reply timely and/or complete, Applicant requests an extension of time under 37 CFR §1.136(a) in the necessary increment(s) of month(s) to render this reply timely and/or

complete and the Commissioner is authorized to charge any necessary extension of time fee under 37 CFR §1.17 to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,
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May 25, 2006
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